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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,003

04/08/2004

Susanne Rathjen

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PROPAT, L.L.C.

425-C SOUTH SHARON AMITY ROAD

CHARLOTTE, NC 28211-2841

EXAMINER

CHAWLA, JYOTI

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,003	Applicant(s) RATHJEN, SUSANNE	
	Examiner Jyoti Chawla	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group II in the reply filed on September 21, 2007 is acknowledged, i.e., claims 8-15 and 21-24. Claims 1-7 and 16-20 have been cancelled and elected claims 8-15 and 21-24 are pending and examined in the application. This Election is made FINAL.

Oath /Declaration

Application 10/637283, listed as pending has since been abandoned.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-15 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-15 and 21-24 contain the trademark/trade name "neotame". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "neotame" and, accordingly, the identification/description is indefinite.

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Claims 15 and 21-24 are indefinite for the recitation of abbreviations, i.e., "bowsc" and "bowf" which render the claim indefinite because it is unclear as to what the above mentioned abbreviations stand for. Clarification is required. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

(A) Claims 8-15 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al., in view of the combination of Calderas et al (US 6294214) and Ishida et al (US 6372279 B1).

Simon et al., hereinafter Simon teaches that the combination of simple sugars and high intensity sweeteners as reduced calorie sweetener combination wherein the calories of the sweeteners are reduced by 50-70% and equate the taste and flavor and feel of the sugared beverages or foods (pages 331 and 332). Simon also teaches a combination of acesulfame K and high fructose corn syrup (HFCS) was known to be added to foods, see entire document, especially Figures 10 and 11. The reference does not equate the

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taste to HFCS 55, as instantly claimed. HFCS 55 comprises of 55% fructose and is slightly sweeter than regular sucrose.

Calderas et al, hereinafter Calderas teaches that it is conventional to use HFCS-42, HFCE-55, and HFCS-90 in combination with artificial or no caloric sweeteners such as acesulfame (see entire patent, especially column 8, lines 42-65).

Ishida et al, hereinafter Ishida, teaches that the combination of N-[N-(3,3-dimethylbutyl)-L-.alpha.-aspartyl]-L-phenylalanine 1-methyl ester or (neotame) and acesulfame K work synergistically. Ishida also teaches that the combination of N-[N-(3,3-dimethylbutyl)-L-.alpha.-aspartyl]-L-phenylalanine 1-methyl ester or (neotame) and acesulfame K, where acesulfame K is 10-97% by weight of the mixture which includes applicant's recited proportion of at least 10:1 (Abstract). Ishida also teaches that the combination of neotame and acesulfame K can be added to food and beverages in a suitable amount, either replacing part or whole of the sweetening composition (Columns 3-4 and claim 11).

Thus the combination of carbohydrate sweeteners, such as, sucrose HFCS 42 and HFCS 55 with high intensity sweeteners, such as acesulfame K was known at the time of the invention (Simon and Claderas). To combine more than one high intensity sweeteners, such as, N-[N-(3,3-dimethylbutyl)-L-.alpha.-aspartyl]-L-phenylalanine 1-methyl ester or (neotame) and acesulfame K, in the ratio recited by the applicant was also known in the art at the time of the invention (Ishida). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Simon in view of Calderas and Ishida and include a combination of neotame and acesulfame K in the proportion as taught by Ishida because the two high intensity sweeteners work well together to provide a sweet taste without the undesirable flavor or after taste. One would have been further motivated to do so as the resulting sweetener would have 50-70% reduced calories as compared to sucrose and a similar taste profile.

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Regarding claims 9 and 12, the Ishida reference teaches that the combination of neotame and acesulfame K can be added in varying amounts to the sweetener composition and also to foods and beverages (Column 4). It is further noted that the claimed amounts, in the absence of a showing to the contrary, are deemed a matter of choice and at most optimization. It is conventional in the art to manipulate sweetener blends to obtain desired results.

Regarding claim 10, Simon, and Ishida both teach of sucrose as part of the sweetener composition.

Regarding claim 11, it is noted that the claimed amounts of sucrose and HFCS 42 are deemed a matter of choice and at most optimization. It is conventional in the art to manipulate sweetener blends to obtain desired results because the use and manipulation of sucrose (sugar) and HFCS in the sweetener art is conventional. Therefore, it would have been a matter of routine optimization experimentation for one of ordinary skill in the art at the time of the invention to modify the relative proportions of sucrose and HFCS in order to optimize cost, taste, flavor and texture of the sweetener.

Regarding claim 13, Ishida teaches combination high intensity sweetener where acesulfame K is 10-97% by weight of the sweetener mixture (Abstract) which includes applicant's recited proportion of at least 10:1 to 450:1. Ishida also teaches that the combination of neotame and acesulfame K can be added to food and beverages in a suitable amount, either replacing part or whole of the sweetening composition (Columns 3-4 and claim 11).

Regarding claims 14 and 15, Simon and Ishida teach that the amount of sweetener in a food composition can be varied based on the desired flavor, taste and food or beverage type. Further, it is conventional in the art to manipulate sweetener amounts to obtain desired results. Therefore, it would have been a matter of routine determination for one of ordinary skill in the art at the time of the invention to modify the relative proportions of sweetener in the food in order to optimize the taste, flavor and texture of the food or

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beverage and altering the amount of sweetener in a food or beverage would not impart patentable distinction to the claims, absent any clear and convincing evidence and/or arguments to the contrary.

Regarding claim 21, the limitation recited in the claim are the same as recited in claims 8 and 14, thus claim 21 is rejected for the same reasons as discussed above in the rejection of claims 8 and 14.

Regarding claim 22 and 23, the limitation recited in the claim are the same as recited in claim 9, thus claim 22 and 23 are rejected for the same reasons as discussed above in the rejection of claim 9.

Regarding claim 24, the limitation recited in the claim are the same as recited in claims 13, thus claim 24 is rejected for the same reasons as discussed above in the rejection of claims 13.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be

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commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-15 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 8, 9 and 13 of copending Application No.11/035590. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim reduced calorie sweetener combinations made with carbohydrate sweeteners consisting of HFCS 42, HFCS 55 and sucrose and high intensity sweetener combination of neotame and acesulfame K in similar proportions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 8-15 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No.10/638721. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim reduced calorie sweetener combinations made with carbohydrate sweeteners consisting of HFCS 42, HFCS 55 and sucrose and high intensity sweetener combination of neotame and acesulfame K in similar proportions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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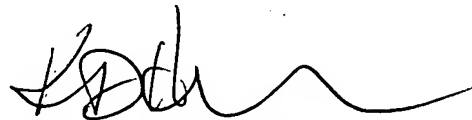
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jyoti Chawla
Examiner
Art Unit 1794



KEITH D. HENDRICKS
SUPERVISOR EXAMINER